



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Appln. Horton, Wade C.

Art Unit: 3633

Appln. No.: 10/825,836

Examiner: Figueroa, Adriana

Filed: 4/17/2004

Confirm. No.: 8772

For: ACCENT FRAME

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APPEAL BRIEF

Sir:

Further to Appellant's Notice of Appeal filed 10 July 2009, an Appeal Brief is submitted herewith in triplicate. This is an Appeal from the final rejection of claims 1-4, 6, 9-11, 13 and 14 of the subject application. No claims stand allowed.

REAL PARTIES IN INTEREST

The real party in interest is Mr. Wade C. Horton, 2922 Rosalie Avenue, Baltimore, Maryland 21234-7615.

RELATED APPEALS AND INTERFERENCES

Appellant avers that there are no other prior or pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal

#### STATUS OF CLAIMS

Claims 1-4, 6, 9-11, 13 and 14 are pending in this application. Claims 5, 7 and 12 were previously canceled during prosecution. Claim 8 was previously withdrawn. The rejection of claims 1-4, 6, 9-11, 13 and 14 is appealed. Please see Appendix A for a copy of the claims under Appeal.

#### STATUS OF AMENDMENTS

The application was filed on April 17, 2004. A first Official Action was mailed on May 2, 2006, and Appellants timely responded with an Amendment dated July 31, 2006. A second and final Official Action was mailed on October 18, 2006. On January 18, 2007, Appellants filed a Response under Rule 1.116 and noted an Appeal on that same day. Appellants received an Advisory Action indicating the Response did not place the application in condition for allowance and continued an appeal, filing their Appeal Brief on June 29, 2007 and a Supplemental Appeal Brief on August 31, 2007. On October 15, 2007, the Examiner withdrew the case from Appeal and issued a non-final Official Action to which the Applicant filed another Amendment in response on April 15, 2008. Examiner again finally rejected all claims on July 25, 2008 and Applicant requested an interview that took place on September 23, 2008 at which Applicant and Examiner tentatively agreed on acceptable claim language pending an additional search. Applicant filed an Amendment reciting the agreed to amendments and a Request for Continued Examination on October 27, 2008. Examiner issued yet another non-final rejection on December 9, 2008 and, after an unsuccessful second Examiner Interview Applicant filed an amendment on February 25, 2009 which was finally rejected on June 10, 2009. Appellants filed a Notice of

Appeal on 10 July 2009. Thus the status of the claims is as amended per Appellant's February 25, 2009 Amendment.

#### SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is an accent frame 5 for an inset article (i.e. recessed lighting fixture (FIG. 2, Ref. #21), ducting system, etc. The accent frame 5 may take on any geometric shape or the shape of any object including a star, flower, or house. FIG. 1 is a plan view of one embodiment of the present invention, namely a star-shaped accent frame 5. FIG. 2 is a perspective view of a flower-shaped accent frame 5 for a recessed lighting fixture 21, showing the means of installation with the various components separated. The inset article 21 has a standard finishing ring 53 to cover the joint between the inset article 21 and the cutout 20 so as to hide any imperfections in the cutout 20. [page 7, para 0006]. The accent frame 5 is larger than the finishing ring 53. Thus, the accent frame 5 of the present invention surrounds the cutout 20, and serves as a decorative transition between the surrounding structure 30 and the finishing ring 53. The frame 5 also covers up any imperfections in the finish or cut of the surrounding ceiling, wall, or floor 30 resulting from the installation process of the inset article 21, that are not covered by the finishing ring 53, and thereby provides an aesthetically pleasing appearance. [page 8, para 0002]

As seen in FIGs. 1 & 2, the accent frame 5 is comprised of a thin sheet of rigid material. The frame 5 is provided with an inner edge defining an aperture 6, which generally corresponds in size and shape to the cutout 20 in the wall, ceiling, or floor structure 30 for the inset article 21. A lip 10 extends rearward from the aperture 6 into the cutout 20 to serve as a proper guide for positioning. An outer edge 7 of the accent frame 5 defines a patterned perimeter in a geometric

shape or an object-shape such as a star (FIG. 1), a flower (FIG. 2), or a house (FIG. 3).

Additionally, the frame 5 can be colored (by painting or molding from pigmented material) with one or more colors, which depict the object suggested by the shape of the patterned perimeter.

[page 8, para 0004].

The material of the accent frame 5 may be designed to sit flush against the wall, ceiling, or floor structure 30 and sufficiently thin so that no perceptible dimension of thickness is apparent to an observer. The accent frame 5 may be formed with a slight convex curvature to insure that it remains in contact with the surrounding wallboard when the inner edge is pressed against the wall, ceiling or floor 30 by the finishing ring 53. [page 9, para 0001]. Alternately, the accent frame 5 may slightly flare away from the structure 30 to provide an aesthetically pleasing depth or texture to the frame. FIG. 2 shows that the frame 5 may flare out, for example, in the shape of a blooming flower. [page 9, para 0002].

The frame 5 may be constructed of lightweight materials including metal, plastic, wood, or a combination thereof, such that it is sufficiently rigid to maintain a horizontal or vertical orientation parallel to the cutout 20 and to remain in contact with the wall or ceiling 30 when installed. Additionally, the frame 5 may be cut to shape or formed by injection molding. [page 10, para 0002]. The frame 5 is preferably formed with a thickness of approximately 1 mm, which is sufficiently thin as not to be readily visible when viewed along a line parallel to the surface of the wall, ceiling, or floor 30. This thin frame 5 can be easily installed between the finishing ring 53, provided by the manufacturer, and the ceiling 30 without altering or purchasing a custom accent ring. [page 10, para 0003].

In use, the accent frame 5 can be easily installed by a homeowner by centering the frame aperture 6 upon the cutout 20 in the wall, ceiling, or floor 30, created for inseting the article 21.

The lip 10 assists in positioning the frame 5. A typical recessed lighting fixture 21 includes a finishing ring 53 that connects to the recessed lighting fixture 21 by expandable tension clips/slots 54a, 54b. The finishing ring 53 is placed over the accent frame 5 and attached to the recessed lighting 21 using the clips/slots 54a, 54b. The finishing ring 53 secures the frame 5 in place. A portion of the accent frame 5 adjacent to the aperture 6 will be confined between the finishing ring 53 and the wall or ceiling 30, and the remaining portion of the frame 5 will be disposed about the area surrounding the fixture 21. [page 9, para 0003].

Independent claim 1 is an apparatus claim based on the accent frame 5 for framing an article inset 21 within a cutout 20 of a structure 30, said inset article 21 including a finishing ring 53 for providing a transition from said article 21 to said structure 30. [page 7, para 0006]. The accent frame 5 requires:

a rigid thin sheet of material larger in size than the finishing ring 53, said rigid thin sheet having an outer edge 7 defining an object-shape and a convex inner edge defining an aperture 6 having a lip 10 for proper positioning with said cutout 20 [page 8, para 0003-0004], wherein said cutout 20 comprises slots 54b and said finishing ring 53 comprises expandable tension clips 54a for insertion through said aperture 6 and said slots 54b thereby securing said frame 5 in place between said finishing ring 53 and about the cutout 20 and against the structure 30; whereby said accent frame 5 serves as an aesthetically pleasing backdrop to said finishing ring 53 and serves to cover up any imperfections in the finish or cut of the surrounding structure 30. [page 9, para 0003].

The above constitute a concise explanation of the invention defined in independent claim 1 and depending claims 2-4, 6, 9-11, 13, and 14 involved in the Appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A single ground of rejection is presented for review on appeal, set forth as follows:

1. Whether claims 1-4, 6, 9-11, 13 and 14 are obvious under 35 U.S.C. 103(a) over U.S. Patent No. 3,697,742 to Bobrick in view of U.S. Patent No. 4,800,239 to Hill?

APPELLANTS' ARGUMENT

1. Whether claims 1-4, 6, 9-11, 13 and 14 are obvious under 35 U.S.C. 103(a) over U.S. Patent No. 3,697,742 to Bobrick in view of U.S. Patent No. 4,800,239 to Hill?

A. Claims 1-3, 6, 9-11, 13 and 14:

According to the Examiner, claims 1-4, 6, 9-11, 13 and 14 are obvious under 35 U.S.C. 103(a) over U.S. Patent No. 3,697,742 to Bobrick ("Bobrick") in view of U.S. Patent No. 4,800,239 to ("Hill"). The Examiner contends that Bobrick shows a recessed lighting fixture mounted on one side of a planar surface, the surface having a cutout above which the lighting fixture is mounted and a finishing ring (46) mounted on the other side of the planar surface, having an aperture conforming to the cutout and attached to the lighting fixture so as to provide a transition from the planar surface to the fixture. The Examiner acknowledges, however, that Bobrick does not disclose elements of the present invention including an accent frame comprising a rigid thin sheet of material having an outer edge defining a shape in two dimensions, an inner edge defining an aperture conforming to the cutout of the planar surface, and an annular lip circumscribing the inner edge and extending upward so as to position the accent frame in the cutout of the planar surface. The Examiner further acknowledges that Bobrick is silent as to maintaining such an accent ring in place by pressure of the light fixture

finishing ring nor the aesthetic impact of the accent frame as a fixture backdrop and concealer for planar surface imperfections. The Examiner asserts that Hill discloses the absent elements of the present invention in the context of a wall plate, save for the annular lip for which the Examiner returns to Bobrick. Applicant disagrees.

Applicant acknowledges that Bobrick discloses a generally conventional recessed light fixture<sup>1</sup> for mounting on one side of a planar surface over a cutout there through. Hill, however, in combination with Bobrick fails to provide the missing elements of Applicant's claim 1 and claims dependent thereon. Claim 1 literally requires an accent frame that has "a convex inner edge defining a circular aperture conforming to said cutout, and having an annular protruding lip circumscribing said aperture and protruding rearwardly there from". The Examiner asserts that Hill shows "a convex inner edge (c) defining an aperture conforming to the cutout, and having an annular lip (l) circumscribing the aperture." (Alphabetic reference characters are as labeled in the Examiner's annotated FIG. 1 excerpted from Hill— see 6/10/09 Official Action at pg. 8).

The Examiner's analysis is in error as the over-frame of Hill, as best seen in Hill's FIG. 3 or FIG. 1 (properly analyzed), is not convex as in the present invention, but is perfectly flat. Further, the element identified as (c) in the annotated Hill FIG. 1 is a part of the outer edge of Hill's over-frame 10 (not inner edge as claimed) and is simply a decorative scalloping effect provided at the corners in the exemplary depiction, as seen in Hill's FIG. 2. As noted, there is simply no convex edge of outer-frame 10 which, as stated, is entirely flat. Annotated element (c) does not provide a convex curvature in the third dimension in order to ensure contact of the accent ring with the surrounding planar surface (e.g. wall, ceiling 5 or floor 30) when the inner

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<sup>1</sup> It is however noted that trim ring claimed in Bobrick is one of the few trim ring designs with which the present accent ring is incompatible.

edge is retained by the finishing ring 53 as the Applicant claims. See Specification, page 9, ¶ 0001. The Examiner simply gives Hill undue credit for teaching the convex edge.

The Examiner further asserts that “it would have been an obvious matter of design choice to modify the rigid thin sheet material [of Hill] to have a convex inner edge defining a circular aperture,” as such a modification is simply a change in shape that is generally recognized as within the level of ordinary skill in the art. Applicant submits that modifying Hill’s rectangular aperture to define a circular aperture may well be within the level of ordinary skill but that doing so does not result in a convex inner edge. The Examiner appears to confuse the change in aperture shape with the introduction of the convex nature of the edge. Introducing a convex curvature to the flat over-frame of Hill would require an entirely separate modification that is beyond a simple change in shape. The additional curvature in a new, third, dimension is not separately asserted by the Examiner as within the level of ordinary skill and is not within that level of skill.

A rejection under 35 U.S.C. §103 is authorized in the MPEP where it is necessary to modify a reference to meet the claim, but requires the Examiner to state in the Office action an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art. MPEP 706.02(j). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Id.* citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner has provided no reasoning whatsoever as to why it would have been obvious to modify the flat over-frame of Hill to add a convex curvature in the third dimension and has thus failed to



meet the minimum requirements of the MPEP to support a rejection under §103. No such modification is taught or suggested in the cited references and the Examiner again gives undue credit to Hill and to the person having ordinary skill to modify the flat outer-frame 10 of Hill into a third dimension to achieve the presently claimed convex edge.

B. Claim 4:

Claim 4, which is separately argued on this Appeal, further claims the accent ring of claim 1 wherein the outer edge of the frame flares away from the planar surface to provide depth or texture (as in a shadow line, etc.) to the fixture. See Specification, page 9, ¶ 0002 and FIG 2. The exemplary depiction of this embodiment is a flower in which the distal portions of the petals (the outer edge) flare away from the ceiling to provide visual effect while the light aperture occupies the flower's center. This is, as above, distinguished from the over-frame 10 of Hill which, again, is entirely flat and which remains in contact with the planar surface at its distal or outer edges. See e.g. Hill FIGS. 3 & 4. The present claim 4 requires an accent frame that is initially concave at the inner edge to ensure initial contact of the rigid thin sheet of material with the planar surface and which then flares away from that surface at its distal or outer edge to provide visual appeal. Hill simply does not disclose such a flared edge and the Examiner again gives Hill undue credit for teaching the same. The Examiner asserts in the annotated FIG. 1 of Hill that the element labeled (p) shows the accent frame flared away from the planar surface. Inspection of the annotated figure by the Applicant reveals no such flared edge and the Examiner's indication that such is disclosed is a mistaken interpretation of the figure. Over-frame 10 maintains contact with the wall at all points including point (p) and is neither convex at its inner edge nor flared at its outer.

\* \* \* \* \*

For the reasons set forth herein, it is believed that the Examiner erred and that this application clearly and patentably distinguishes over the prior art. Reversal is respectfully requested.

Respectfully Submitted,



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APPENDIX A: Claims Under Appeal

1. In combination with a ceiling, wall or floor comprising a planar surface defined by opposing sides and having circular cutout there through, a recessed lighting fixture mounted on one side of said planar surface over said cutout and conforming thereto, and a finishing ring defined by an aperture conforming to said cutout, said finishing ring being mounted on another side of said planar surface around said cutout and attached to the recessed lighting fixture for providing a transition from said planar surface to said recessed lighting fixture, an accent frame comprising:

a rigid thin sheet of material, said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape larger in diameter than said finishing ring, and a convex inner edge defining a circular aperture conforming to said cutout, and having an annular protruding lip circumscribing said aperture and protruding rearwardly there from for insertion into, seating within, and proper positioning with said cutout, said accent frame being sandwiched between said finishing ring and planar surface and maintained in place there between by the pressure of said finishing ring being retained to said recessed lighting fixture;

the flat two-dimensional object-shaped outer edge of said accent frame protruding beyond said finishing ring and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface.

2. The accent frame of claim 1, further comprising a decorative outer edge.
3. The accent frame of claim 1, wherein said accent frame is seated flush with said planar surface.
4. The accent frame of claim 1, wherein said frame flares slightly away from the planar surface to provide an aesthetically pleasing depth or texture to the frame.
5. (Canceled)
6. The accent frame of claim 1, wherein said thin sheet of material is approximately 1 mm thick.
7. (Canceled)

8. (Withdrawn)

9. The accent frame of claim 1, wherein said planar surface is a surface selected from the group consisting of a ceiling, wall and floor.

10. The accent frame of claim 1, wherein said frame is constructed of a rigid material selected from the group consisting of wood, metal and plastic materials.

11. The accent frame of claim 1, wherein said frame is formed by injection molding.

12. (Canceled)

13. The accent frame of claim 1, wherein said frame is both decorative and covers up any imperfections in the edges of the cutout not covered by the finishing ring.

14. The accent frame of claim 1, wherein said object-shape is a closed form selected from the group consisting of a star, flower, and house.

APPENDIX B: Evidence Appendix

There has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 nor any other evidence entered by the Examiner and relied upon by appellant in the appeal.

APPENDIX C: Related Proceedings Appendix

There are no related appeal proceedings, nor any decisions rendered by a court or the Board in any related appeal proceeding.